REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed April 8, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 11-14 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Levine, et al. ("Levine," U.S. Pat. No. 5,974,234). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b). In the present case, not every feature of the claimed invention is represented in the Levine reference.

Applicant's independent claim 11 provides as follows (emphasis added):

> 11. A method of printing over a network, comprising:
>
> ***accessing a thin print server having no physical user interface*** from a remote computer;
>
> through the remote computer, ***managing the thin print server such that the thin print server*** discovers one or more printers connected to the network and ***creates one or more shared network print objects***, each shared network print object representing a printer connected to the network as a shared network printer;

designating a shared network print object from an application program executing on the remote computer;

sending a print job from the remote computer to the designated shared network print object for printing;

receiving the print job at the thin print server;

managing the print job at the thin print server in one or more print queues; and

forwarding the print job from the thin print server to a shared network printer for printing.

As is apparent from the above, Applicant has, *inter alia*, amended claim 11 to recite a "thin print server having no physical user interface". Applicant respectfully submits that Levine teaches no such thin print server. In contrast, Levine discloses a proxy server 107A that couples clients with document processing devices. At no point in the Levine disclosure is the proxy server described as a thin server or thin print server.

The difference between a general purpose server (such as that disclosed by Levine) and a thin server is significant to persons having ordinary skill in the art. As is described by Applicant on page 12, lines 5-18 of the application:

> as a thin server, the network print appliance 402 is optimized to deliver only the capabilities for which it is designed, without including unnecessary software or hardware features related to other general purpose network servers or computers. For example, the network print appliance 402 is designed to be accessed, managed, and utilized from remote locations only, such as from a remote computer 404 or remote server 408, and therefore provides no physical user interface. Thus, elements described above pertaining to computer 404 that are typically not a part of the appliance 402 include various input devices, such as the keyboard 534, pointing device 536, microphone, joystick, game pad, satellite dish, scanner, and the like. Other elements described

above pertaining to computer 404 which are not typically a part of the network print appliance 402 include the display device and other peripheral output devices such as speakers.

Given that Applicant's recitations of a "thin print server" and the various tasks being performed by that server must be afforded patentable weight, Levine, or another reference cited against Applicant's claims, must teach or suggest a thin print server that performs those tasks. Because Levine provides no such teaching or suggestion, Applicant respectfully submits that Levine cannot anticipate or render obvious Applicant's claims 11-14.

As a further point, Applicant notes that Levine fails to disclose a thin print server, or other component for that matter, that "creates one or more shared network print objects", as is explicitly recited in Applicant's claim 11.

Due at least to the above-noted shortcomings of the Levine reference, Applicant respectfully asserts that Levine does not anticipate Applicant's claims 11-14. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Mansbery, et al. ("Mansbery," U.S. Pat. No. 6,121,593) in view of Levine. Applicant respectfully traverses this rejection.

As acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596,

1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be some prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference.

Mansbery discloses a control system that is used to control home appliances, such as a refrigerator and oven. As is described by Mansbery (column 1, lines 11-40):

> Many families today have two wage earners and as a consequence, there can be a significant delay when they both return from work before the evening meal can be prepared. Not only that, but sometimes their schedules change during the day so that the time when the evening meal is to be prepared must be changed. . . . The instant invention contemplates the remote actuation of home appliances using a specific control system. The invention also contemplates the concept of actuating a combination cooling and heating mechanism from a remote location so that food may be preserved in a refrigerated state during a finite period of time and then the refrigeration may be turned off and the cooking system may be actuated from a remote location.

In view of the above, it is clear that the Mansbery disclosure is only directed to the problem of remotely controlling home appliances, such as a refrigerator/oven appliance, for purposes of meal preparation. Because of this fact, it is difficult to understand how the Mansbery reference can serve as a base reference in a rejection against claims to a "network print appliance" or a "system for printing over a network".

Irrespective of whether the Mansbery disclosure is an appropriate reference to cite against Applicant's claims, Applicant notes that the Mansbery disclosure is deficient as to many explicitly recited features of Applicant's claims. With reference first to Applicant's independent claim 1, Applicant recites (emphasis added):

1. A ***thin print server having no physical user interface***, the thin print server comprising:

one or more processors;

a memory associated with the one or more processors;

a network interface providing full-time connection to a network and remote access to the thin print server by one or more client computers;

a user interface module stored in the memory and executable on the one or more processors providing remote management of the thin print server by the one or more client computers, the user interface module precluding local management of the thin print server;

a ***printer administration module*** stored in the memory and executable on the one or more processors for discovering one or more printers connected to the network and creating one or more shared network print objects, each shared network print object representing a printer connected to the network as a shared network printer; and

a ***printer serving module*** stored in the memory and executable on the one or more processors for receiving print jobs, managing print queues, and forwarding print jobs to a shared network printer for printing.

As a first matter, Applicant notes that because Mansbery is directed to meal preparation control, Mansbery does not teach or suggest a "thin printer server". Indeed, Mansbery says nothing whatsoever about printing. As a second matter, Applicant notes that Mansbery does not disclose a thin print server, or other thin server, that has "no physical user interface". To the contrary, Mansbery explicitly shows and describes

elements that comprise such an interface used in conjunction with Mansbery's "computer." For example, Mansbery shows a keyboard 23 and a display 22 in Figure 1.

Given that Mansbery says nothing about printing, Mansbery also does not teach or suggest a "printer administration module" or a "printer serving module". Specifically, if Mansbery is silent as to printing, how can Mansbery teach a *printer* administration module or a *printer* serving module?

With specific regard to the printer administration module, Mansbery also fails to teach or suggest a module for "discovering one or more printers connected to the network" or "creating one or more shared network print objects, each shared network print object representing a printer connected to the network as a shared network printer". Since Mansbery's invention is not concerned with printing, there would be no reason to provide a module that performs those functions.

Regarding the printer serving module, Mansbery fails to teach or suggest a module for "receiving print jobs, managing print queues, and forwarding print jobs to a shared network printer for printing". Once again, because Mansbery is not concerned with printing, it follows that Mansbery's system includes no module that performs those printing functions.

In recognition of the fact that the Mansbery disclosure has nothing to do with printing, the Levine reference is cited in combination with Mansbery to reject Applicant's claims. In the Office Action, it is argued:

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network appliance taught by Mansbery to include details of a printer server as taught by Levine so that the network appliance can manage printers and print jobs remotely (Mansbery, column 4, lines 38-42; column 4, lines 1-5).

Applicant respectfully questions the logic of this argument. Specifically, Applicant questions why a person having ordinary skill in the art would be motivated to "modify" the Mansbery system to manage printers and print jobs. If such a modification were made, the Mansbery system would fail to perform the core function for which it was designed: to enable remote meal preparation. Therefore, the proposed modification would disable the primary functionality of the Mansbery system.

If the Office Action is suggesting mere addition of the print control functionality to the Mansbery system, Applicant questions why a person having ordinary skill in the art would be motivated to append such a functionality to a meal preparation control system. Is the argument that a home owner could start a meal and print a document from a remote location? Such a combination simply does not make sense. Applicant respectfully submits that a person having ordinary skill in the art would not consider such a modification without hindsight to Applicant's own disclosure or claims. Such use of hindsight to the applicant's invention is improper in formulating a rejection of the applicant's claims.

In view of the above, Applicant respectfully submits that claim 1 is allowable over Mansbery and Levine. Because claims 2-5 incorporate all of the limitations of claim 1, they are likewise allowable over Mansbery and Levine. Applicant also notes that those claims contain further limitations that are not taught or suggested by either Mansbery or Levine. For instance, with reference to claim 3, Applicant notes that neither Mansbery nor Levine teach a module that "is required to create the one or more shared network print objects . . . thereby preventing the creation of a shared network print object on any other network device". In addition, regarding claim 4,

Mansbery and Levine fail to teach a "printer administration module that is pre-installed". Applicant respectfully submits that the "pre-installed" recitation comprises an explicit limitation that cannot be ignored when formulating a rejection of claim 4.

Regarding independent claim 6 and its dependents, Applicant refers to the statements provided above regarding Mansbery's lack of disclosure as to printing and a "thin print server" having "no physical user interface". As a further point, Applicant notes that Mansbery does not teach or suggest a server that is "configured to discover the one or more network printers and create one or more shared network print objects" or "configured to receive a print job, manage print queues, and forward a print job to a shared network printer for printing" as are also recited in claim 6. Regarding dependent claims 8 and 9, Applicant refers back to the discussion provided above in relation to claims 3 and 4 above.

In view of the foregoing, it is respectfully submitted that each of claims 1-10 is patentable over Mansbery/Levine and that the rejection of these claims should be withdrawn.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

July 1, 2004

Mary Meegan

Signature